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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/975,457	10/11/2001	Gordon T. Brown	47781-7	9832

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EXAMINER

COSIMANO, EDWARD R

ART UNIT	PAPER NUMBER
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2161

DATE MAILED: 02/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/975,457

Applicant(s)

BROWN, GORDON T.

Examiner

Edward R. Cosimano

Art Unit

2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-82 is/are pending in the application.
- 4a) Of the above claim(s) None is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28-82 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 October 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other: _____

Art Unit: 2161

1. Applicant should note the changes to patent practice and procedure:

A) effective December 01, 1997 as published in the Federal Register, Vol 62, No. 197, Friday October 10, 1997; and

B) effective November 07, 2000 as published in the Federal Register, Vol 65, No. 54603, September 08, 2000.

2. The drawings are objected to because

A) the drawings must show every feature of the invention specified in the claims, therefore, the subject matter of:

(1) claim 32, in regard to using the recited menu; and

(2) claims 45-60, 80 & 81, in regard to the recited structure of the system used to implement the invention, i.e. computers, input devices, output devices, networks, etc.;

must be shown in the drawings as required by 37 CFR § 1.83(a) or the feature(s) canceled from the claim(s) (note: no new matter should be entered).

B) the following errors have been noted in the drawings:

(1) The drawings are objected to as failing to comply with 37 CFR § 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description:

(a) 290 as disclosed in the paragraph at page 11, lines 8-14, "After this, the ordered reports ... at box 290. Ten ... faster than currently available services."; and

(b) as disclosed in the paragraph at page 13, lines 8-13, "If an adjust future action ... line 361 leads ... the funds transfer facility is exited.".

(2) The drawings are objected to as failing to comply with 37 CFR § 1.84(p)(4) because as can be seen in figs. 3 & 4, reference number 261 has been used twice to designate different features of the invention, note the paragraphs at:

Art Unit: 2161

(a) at page 11, lines 15-16, "After this, line 261 ... next account to be processed."; and

(b) at page 13, lines 8-13, "If an adjust future action ... line 361 leads ... the funds transfer facility is exited."

(3) as can be seen in fig. 4 and from the context of the paragraph at page 13, lines 8-13, "If an adjust future action ... line 361 leads ... the funds transfer facility is exited.", in fig. 4 "261" should be --361--.

2.1 A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

2.2 Applicant is required to submit a proposed drawing correction in reply to this Office action. However, formal correction of the noted defect may be deferred until after the examiner has considered the proposed drawing correction. Failure to timely submit the proposed drawing correction will result in the abandonment of the application.

3. The disclosure is objected to because of the following informalities:

A) applicant must update:

(1) the continuing data on page 1,

with the current status of each of the referenced applications, e.g., --now abandoned--, or --now patent #?--, or --which is abandoned and now serial number #?--, etc.

B) the specification lacks an explicit reference to the nature of:

(1) reference legend(s):

(a) 261 of fig. 4 in the paragraph at page 13, lines 8-13, "If an adjust future action ... line 361 leads ... the funds transfer facility is exited."; and

(2) how the program proceeds after:

(a) box 140 of fig. 2 if the inquiry is either "YES" or "NO" in the paragraph at page 8, lines 20-25, "Line 113 then leads to ... to exit the ledger routine 144.";

Art Unit: 2161

as required by 37 CFR § 1.84(p(5)) and 37 CFR § 1.121(e). It is noted that merely mentioning a number with out mentioning the device or operation of the step relies on the drawing to provide support for the disclosure and not to aid in the understanding of the invention, as is the purpose of the drawings (37 CFR § 1.81(a,b)).

C) the following errors have been noted in the specification:

(1) the disclosure lacks an explicit reference to fig. 4 as figure 4 is described in the paragraphs between page 11, line 17, and page 13, line 13, If the funds ... the funds transfer facility is exited.”.

D) the subject matter of:

(1) claim 32, in regard to using the recited menu;

lacks antecedent basis within the specification as required by 37 CFR § 1.75(d1).

Appropriate correction is required.

4. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(a)-1.121(f) & § 1.121(g)-1.121(h).

5. Claim 32 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5.1 The subject matter of:

(1) claim 32, in regard to using the recited menu;

lacks antecedent basis within the specification as required by 37 CFR § 1.75(d1).

5.2 Claims not specifically mentioned above, inherit the defects of the base claim through dependency. For the above reason(s), applicant has failed to particularly point out what is regarded as the invention.

Art Unit: 2161

6. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

(c) Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

6.1 Claims 28-82 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the systems The Budd Co. and the "big three" auto makers disclosed in Kniffen as applied to claims 2-7, 14-17 & 21-28 of base application 08/313,988 and which was set forth in the final rejection mailed May 22, 1997 (see attached copy) and affirmed by the Board of Patent Appeals and Interferences on August 15, 2001. Since the instant claims and the claims of base application 08/313,988 are not patentably distinct, this rejection is based on the Res Judicata (MPEP 706.03(w)).

7. Claims 28-82 are rejected under the judicially created doctrine of double patenting over claims 1-18 of U. S. Patent No. 5,875,435 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

7.1 The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

A) assigning codes to financial transactions;

B) recoding financial transaction information including an transaction code assigned to the financial transaction;

Art Unit: 2161

C) collecting the recorded transaction information;

D) sorting/organizing and editing the collected the collected transaction information for an entity based on the assigned code; and

E) providing the organized transaction information to the entity.

7.2 Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

7.3 The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

7.4 A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

7.5 Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. 35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

8.1 Claims 34-38, 44, 78, 79 & 82 are rejected under 35 U.S.C. § 101 because the invention as claimed is directed to non-statutory subject matter.

Art Unit: 2161

8.1.1 The instant claims recite a system/device, (claims 34-38, 78 & 79) or a carrier wave (claims 44 & 82), which has a practical application in the technological arts, and which does not merely define either a computer program, a data structure, non-functional descriptive material, (i.e. mere data) or a natural phenomenon. Hence, the instant claims merely define device/wave that contains a series of steps that could be but are not necessarily to be performed on a computer.

8.1.2 It is further noted that applicant has not recited a specific machine since the operations recited in the claims are merely to illustrate the operations of the instant invention since these operations are not in fact implemented by a processor/computer. Hence, applicant envisions the invention as recited in claim 34-38, 78 & 79 as a disembodied storage device, i.e. memory, or recited in claims 44 & 82 as a disembodied wave, that stores a computer program as a non-functional data structure. Such a disembodied storage device/wave is not a specific machine because:

A) it is not associated with a computer in such a way as to cause the computer to operate in a specific manner, (note In re Beauregard 35 USPQ2d 1383 (CAFC 1995) and the associated claims of U.S. Patent 5,710,578); and

B) a memory device/wave alone can not perform the functions recited within the claims.

Therefore, the recited disembodied storage device/wave, which itself cannot perform the functions recited within the claims as the invention, is inoperative and lacks utility for the purpose of the invention.

8.1.3 In view of the above, the invention recited in claims 34-38, 44, 78, 79 & 82, merely describes an abstract idea of a disembodied storage device/wave, i.e. memory, that stores a computer program as a non-functional data structure, since a disembodied storage device/wave by itself can not produce a concrete and tangible result by performing the functions recited within the claims as the invention. Hence, claims 34-38, 44, 78, 79 & 82 do not have a claimed practical application, since the disembodied storage device/wave is inoperative and therefore lacks utility for the purpose of the invention.

8.1.4 Hence, claims 34-38, 44, 78, 79 & 82 are directed to non-statutory subject matter.

Art Unit: 2161

9. The examiner has cited prior art of interest, for example:

A) McHugh (GB 2251098) which disclose the centralized collection of financial transaction data.

B) Kadlec which discloses the classification of financial transactions.

C) either Kunkler et al (5,740,271) or Chancey et al (5,842,185) which disclose the organization of financial transaction based on standard transaction codes.

10. The shorten statutory period of response is set to expire 3 (three) months from the mailing date of this Office action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell, can be reached on (703)-305-9768. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

11.1 The fax phone number for UNOFFICIAL/DRAFT FAXES is (703) 746-7240.

11.2 The fax phone number for OFFICIAL FAXES is (703) 746-7239.

1.3 The fax phone number for AFTER FINAL FAXES is (703) 746-7238.

02/09/02



Edward R. Cosimano
Primary Examiner A.U. 2161